

### **REMARKS**

In the Office Action, Claims 1, 2, 4-11, 15, 16, 17 were rejected under 35 USC 103(a) over the patent to U.S. patent to Kasabian.

Claims 12, 13, 18 were rejected under 35 USC 103(a) as being unpatentable over the patent to Kasabian in view of the patent to Potter.

Also, the claims were rejected under 35 USC 112.

In connection with the formal rejection of the claims under 35 USC 112 and the rejection of the claims over the art under 35 USC 103(a), the telephone conference was held with the Examiner to discuss the grounds for rejection. The Examiner's highly beneficial cooperation during the conference has been gratefully acknowledged.

During the conference it was determined what clarification would be needed for Claims 1, 7 and 10. With the present Request for Reconsideration applicants amended the claims as was discussed with the Examiner, which changes which the Examiner agreed to enter. Claim 18 has been amended to make it dependent on Claim 12 and provide the basis for the term "the groups."

The Examiner's rejection of the claims over the art has been carefully considered. Claims 1, 7 and 18 specifically define that in the power tool and coolant duct arrangement, the openings (14) have a conical shape.

The Examiner indicated that in her opinion it is necessary to provide arguments related to an obviousness of the conical shape of the openings.

With the present Request for Reconsideration the applicant submitted a Declaration of Unobviousness, which clearly and unequivocally proves that when the power tool and the coolant duct arrangement are designed in accordance with the present invention, in particular with the through openings have a conical shape, this provides for the highly advantageous results which cannot be accomplished by the devices disclosed in the references, and this feature is unobvious and patentable.

Neither the patent to Kasabian nor the patent to Potter disclose the above mentioned new features of the present invention. The only way to arrive at the present invention from the teachings of the references would be to significantly modify the constructions disclosed in the references, in particular by introducing into them the new features of the present invention which are now defined in the above listed claims, in other words, by changing the cylindrical openings to the conical openings.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification. This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

As also explained hereinabove, the present invention provides for the highly advantages results which are explained in detail in the attached declaration. It is well known that in order to support a valid rejection in the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushma and Takahashi* (174 UPSQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of the original skill in the art to rewire prior art devices in order to accomplish applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented marks and amendments it is believed that the independent claims currently on file should be considered as patenting distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on the corresponding independent claims, they contain the allowable features of the independent claims, and therefore they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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**UNITED STATES PATENT AND TRADEMARK OFFICE**

Examiner: Morgan, E.

Art Unit: 3723

Docket No. 3430

In re:

Applicant: DEHDE, J.

Serial No.: 10/550,283

Filed: September 22, 2005

**DECLARATION OF UNOBVIOUSNESS OF THE INVENTION**

June 18, 2008

JÖRG DEHDE, citizen of Germany, whose post office address and residence is Meisenweg 21/1, D-71144 Steinenbronn, Germany, is the inventor of the invention disclosed in the above specified patent application.

I am familiar with the present invention and also familiar with the power tools disclosed in U.S. patent to Kasabian No. 3,840,762 and U.S. patent to Potter 6,296,427.

I hereby declare that the present invention in which the through openings (14) have a conical shape, provide for unobvious and highly advantageous result when compared with the power tools having through openings of a cylindrical shape.

Common coolant duct arrangements have slots to cool an interior of the power tool. The disadvantage of these slots is that the stability of a region where the slots are arranged is weakened. Through an arrangement of openings as defined in the present invention, the cooling of the interior of the power tool is improved and the noise level of the coolant duct arrangement of the power tool is reduced.

In an unobvious and highly advantageous manner, with the use of the conical openings the flow speed is advantageously decreased and thereby the noise level is reduced. The decrease of the flow speed can be attributed to the affect that the cross-section of the conical openings is changing along the linear expansion of the conical openings. The escaping volume flow rate of the coolant duct arrangement expands in the conical openings and thereby the flow speed is decreased. In addition, the expanding volume flow rate of the conical openings causes less turbulence compared to cylindrical openings, which has also a positive effect on the noise reduction of the coolant duct arrangement. Another effect of the reduced turbulence is that less dust is dispersed in the region of the coolant duct arrangement. This has a positive effect on the user-friendliness.

Another advantage of the conical openings is that the cooling effect is raised compared to the duct arrangement with the cylindrical openings, because the surface of the coolant duct arrangement is enlarged by conical openings compared to the cylindrical openings. Furthermore, the enlargement of the surface of the coolant duct arrangement by conical openings has the effect that the volume flow rate can be advantageously raised, whereby the cooling effect will also be raised.

Furthermore, the plate wherein the conical openings are arranged is more flexible compared to a plate with cylindrical openings. Therefore, the plate can advantageously be adjusted to almost every shape of the housing. The angle of the conical openings can especially be changed according to the kind of application area in which the plate in which the conical openings are arranged is used. Furthermore, the angle of the conical openings can also be changed to obtain a special noise level or a special noise spectrum of the coolant duct arrangement, to adjust the conical openings to the noise spectrum of the hand power tool. A hand power tool with low engine performance has a different noise spectrum than a hand power tool with a high engine performance. Therefore, it is advantageous to change the angle of the conical openings of the coolant duct arrangement in such a way that the angle of the conical openings is aligned to the corresponding hand power tool.

It is therefore respectfully submitted that the new features of my invention defined in Claims 1, 7 and 15, in that the through openings 14 have a conical shape, are unobvious and highly advantageous, and should be considered as patentable.

I HEREBY DECLARE AND AFFIRM THAT ALL STATEMENTS made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statement may jeopardize the validity of the above-named application, any patent issuing thereon or any patent to which this Declaration is directed.

Date: 15. Juni 2008

J. Dehde  
Joerg Dehde